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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,006	12/27/2000	Wolfgang von Deyn	47679	4682

2292 7590 07/28/2005

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EXAMINER
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SHIAO, REI TSANG

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/748,006

Applicant(s)

DEYN ET AL.

Examiner

Robert Shiao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on responses filed on 06/06, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4,8-11,14,16 and 21-36 is/are pending in the application.
- 4a) Of the above claim(s) 22,23,33 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4,8-11,14,16,21,24-32,35 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This application claims benefit of the foreign application:  
GERMANY 19701446.1 with a filing date 01/17/1997. The certified copy of the instant foreign priority document has been filed, dated July 12, 2005, therefore, the foreign priority has been granted.
2. Amendment of claims 1-2, and cancellation of claims 5-7, 12-15, 17-20 in the amendment filed on June 6, 2005, is acknowledged. Claims 1-4, 8-11, 14, 16, and 21-36 are pending in the application.

### ***Responses to Amendment and Arguments***

3. Applicant's arguments regarding rejection of claims 1-4, 8-11, 14, 16, 21, 24-32, and 35-36 under 35 U.S.C. 103(a) filed on June 6, 2005, have been fully considered and they are persuasive. Since the priority date of instant application is January 17, 1997, which is prior to the published date (i.e., 11/06, 1997) of WO 97/4115. Therefore, the document WO 97/4115 is not qualified as prior art, and rejection of 1-4, 8-11, 14, 16, 21, 24-32, and 35-36 under 35 U.S.C. 103(a) over Adachi et al. WO 97/4115 is withdrawn herein.
4. Applicant's arguments regarding rejection of claims 1-4, 8-11, 14, 16, 21, 24-32, and 35-36 under obviousness-type double patenting over Bratz et al. US 6,479,437, filed on June 6, 2005, have been fully considered but they are not persuasive. It is noted that the filing date of instant application is December 27, 2000, which is later than the filing date December 05, 2000 of the application No. 09/701875 (now is US

6,479,437). Therefore, the one-way obviousness analysis of the previous Office Action, dated March 04, 2005, is proper. Since a terminal disclaimer has not been filed, therefore, rejection of claims 1-4, 8-11, 14, 16, 21, 24-32, and 35-36 under obviousness-type double patenting over Bratz et al. US 6,479,437, is maintained. Applicants are requested to file a terminal disclaimer to the Office to overcome the rejection.

### ***Objection***

5. Claims 1-4, 8-11, 14, 16, 21, 24-32, and 35-36 are objected to as containing non-elected subject matter, i.e., the variable X represent O, S, NR<sup>9</sup>, or CO, or the variable Y represents CO of claims 24-25, and 30, etc. It is suggested that applicants amend the claims to the scope of the elected subject matter as defined on the pages 2-3 of the previous Office Action, dated March 04, 2005. Claims 22-23 and 33-34 are objected to as being non-elected inventions. Elimination of claims 22-23, and 33-34 would obviate the objection.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Shiao whose telephone number is (571) 272-0707.

The examiner can normally be reached on 8:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on (571) 272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**TAOFIQ SOLOLA**  
**PRIMARY EXAMINER**



Robert Shiao, Ph.D.  
Patent Examiner  
Art Unit 1626

  
Joseph K. McKane  
Supervisory Patent Examiner  
Art Unit 1626

July 25, 2005